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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,992	01/17/2002	Denwood F. Ross III	VTN-0572	4178

27777 7590 12/22/2003  
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EXAMINER

GAGLIARDI, ALBERT J

ART UNIT PAPER NUMBER

2878

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/051,992

Applicant(s)

ROSS ET AL.

Examiner

Albert J. Gagliardi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Comment on Submissions***

1. The response filed 10 September 2003 has been entered.

### ***Claim Objections***

2. Claim 21 is objected to because of the following informalities:

Regarding claim 21, the step of directing inappropriately includes the term “without imaging”. The term should be part of the detecting step.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2 and 4-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-2 and 4-20, the claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

Regarding claims 1-2 and 4-19, the relationship between the reflective foil of the sealed container, the non-imaging detector, and the position or presence of the product in the container relative to the foil container is unclear. The examiner notes that while the detector is positioned to receive energy reflected by the foil, there is no identified relationship between the product and

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the imaging detector. As such it is unclear how the processor acquires the necessary information to determine the position or presence of the product and what, if any effect the reflective foil has on the determination.

Regarding claim 20, the relationship between the reflective surface, the detector, and the position of the product in the container relative to the container is unclear. The examiner notes that while the detector is positioned to receive energy reflected by the reflective surface, there is no identified relationship between the product and the detector. As such, it is unclear how the processor acquires the necessary information to determine the position or presence of the product and what, if any effect the reflective foil has on the determination.

Regarding claims 21-24, the relationship between the reflective foil of the sealed container, the detected energy reflected by the foil, and the determined position or presence of the product in the container relative to the reflective foil is unclear. The examiner notes that while the detector is positioned to receive energy reflected by the foil, there is no identified relationship between the product and the imaging detector. As such it is unclear how the processor acquires the necessary information to determine the position or presence of the product and what, if any effect the reflective foil has on the determination.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-2, 4-19 and 21-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-5, 8-12, 15, 22-24 and 19 of U.S. Patent No. 6,246,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding claims 1-2, 4, 6-7, 10-15, and 21-24, as best understood, the claims are the same as claims 1-3, 4-5, 8-12, 15, 22-24 and 19 respectively except for the requirement that the container be sealed and include a reflective foil lidstock and that the detector be disposed to receive only reflected radiation.

The examiner notes that the limitations relating to the material worked on by the apparatus (i.e., the sealed container with the reflective foil do not suggest any structure that distinguishes the presently claimed apparatus from the apparatus of the patent. (Note: Apparatus claims must be structurally distinguishable from the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). See MPEP 2114.)

Regarding the position of the detector to receive only reflected radiation, the recitation of only a single specific embodiment out of two claimed embodiments (i.e., embodiments that

receive either pass-through or reflected radiation is viewed as an obvious design choice within the skill of a person of ordinary skill in the art.

Regarding the specific recitation of the source as being a pulsed source (claim 5); the specific recitation that the processor includes the use of a lookup table or neural network (claims 8-9); the specific recitation that the detector is a spectrometer including a filter (claims 16-17); and the specific identification of a plurality of detectors as including a specific range of 1-100 detectors or 1-20 detectors (claims 18-19) are well known as functionally equivalent and/or otherwise routine variations, alternative arrangements, or optimal design choices that are typical for optical analysis systems, and therefore do not define any patentable distinction between the claims as recited and those of the U. S. patent.

7. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6548,818 B1). Although the conflicting claims is not identical, it is not patentably distinct from each other because:

Regarding claim 20, as best understood, the claim is the same as claim 19 of the patent except for the requirement that the container be sealed and include a reflective foil lidstock and that the detector be disposed to receive only reflected radiation from the foil and not necessarily from the product or container. The examiner notes that while it is unclear (see indefiniteness rejection above) what, if any, differing structural limitations exist between the presently claimed invention and the claim of the patent, any such differences would have been a matter of routine design choice require only any obvious rearrangement of parts that would not effect the structure of the apparatus.

***Alternate Double Patenting***

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claim 20 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 19 of prior U.S. Patent No. 6,548,818. This is a double patenting rejection.

Regarding claim 20, as best understood, the recited claim is the same as claim 19 of the patent except for the requirement that the container be sealed. As noted above, the material or article worked upon does not impart patentability to an apparatus claim. As such, the claim is viewed as describing the same invention.

***Response to Arguments***

10. Applicant's arguments filed 10 September 2003 have been fully considered but they are not persuasive.

11. Regarding applicant's argument against the §101 statutory double patenting rejection of claims 1-2, 4, 6-7, 10-15 and 21-24, the argument is moot in view of the new grounds of rejection.

12. Regarding applicant's argument against the §101 statutory double patenting rejection of claim 20, the examiner notes that, as best understood, the examiner notes that the material worked upon by the apparatus does not impart patentability to the apparatus and therefore does

not effect the scope of the claimed apparatus. Regardless of applicant's argument, and in view of the amendment as best understood, the argument is insufficient to overcome the new grounds of rejection.

13. Regarding applicant's argument against the nonstatutory double patent rejection of claims 5, 8-9, 16-17 and 18-19, the arguments are not convincing.

Regarding claim 5, the examiner has noted that the use of a pulsed source is a well-known, functionally equivalent design choice typically found in optical analysis systems. As evidence that it is well known (therefore inherently suggesting a reasonable expectation of success) the examiner call applicant's attention to Miller *et al.* (US 5,659,397) which teaches an apparatus measuring reflected radiation wherein the source is pulsed (col. 8, lines 30-44). Miller discloses that such an arrangement has an advantage of known functionally equivalent unpulsed sources in that the measurement is less sensitive to ambient light (i.e., has improved signal-to-noise) and reduces heat transferred to the measured material (col. 8, lines 30-44).

Regarding claims 8 and 9, the examiner has noted that the use of a lookup table or a neural network for processing information in optical analysis systems are well-known, functionally equivalent design choices typically found in optical analysis systems. As evidence that it is well known (therefore inherently suggesting a reasonable expectation of success) the examiner call applicant's attention to Jack *et al.* (US 5,831,267) which discloses a radiation measuring apparatus wherein the processor comprises a lookup table (col. 4, lines 34-43) and Block *et al.* (US 5,424,545) which discloses a radiation measuring apparatus wherein the processor comprises a neural network (col. 9, lines 45-55).



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Regarding claims 16 and 17, the examiner has noted that the use of a spectrometer or a filter for in conjunction with detecting optical information are well-known, functionally equivalent design choices typically found in optical analysis systems. As evidence that it is well known (therefore inherently suggesting a reasonable expectation of success) the examiner call applicant's attention to Purdy *et al.* (US 5,460,177) which discloses a spectrometer (35 of Fig. 1) and Jack which discloses a filter (16 of Fig. 1) for detection of the desired optical radiation of interest.

Regarding claims 18 and 19, the examiner notes that since the patent recites a specific example (i.e., one detector (claim 1) or a plurality of detectors (claim 12) of a number of detectors that within the currently recited ranges (i.e., 1-100 or 1-20), and therefore anticipates the recited ranges (see MPEP 2131.03).

14. Regarding applicant's argument that the claims of the '062 patent fails to teach a container sealed with a lidstock, the examiner notes, as indicated above, that the material worked upon by an apparatus does not patentably distinguish an apparatus.

15. All of applicant's arguments having been addressed or rendered moot by the new grounds of rejection, the rejection is maintained.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert J. Gagliardi whose telephone number is (703) 305-0417 (after January 20, 2003 the number will be (571) 272-2436). The examiner can normally be reached on Monday thru Friday from 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (703) 308-4852. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Albert J. Gagliardi  
Primary Examiner  
Art Unit 2878

AJG